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In re Application of
Tomlins et al.
Application No. 09/470,629
Filed: December 22, 1999
Attorney Docket No. 476-1871
For: COMMUNICATIONS NETWORK

DECISION REFUSING
STATUS UNDER
37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed August 10, 2000 (certificate of mailing date August 7, 2000).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on December 22, 1999 without an executed oath or declaration. Accordingly, on February 8, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on August 10, 2000 (certificate of mailing August 7, 2000), a petition for a four month extension of time and required fee, a declaration executed by 4 of six co-inventors, the surcharge, the petition fee, and the instant petition were filed. The petition was authored by an attorney of record, Mr. William M. Lee, Jr. Mr. Lee explains that the two non-signing inventors, Osama Bhagat and Greg Bernstein, were temporary employees of the assignee company, Nortel Networks Limited, and that their last known address is unknown and they cannot be found.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1), (2), and (4) above.

As to item (1), Rule 47 applicant has failed to show that the inventor cannot be reached. Applicant has simply stated that the Human Resource Department of Nortel Networks Limited has no record of either company identity numbers or any forwarding addresses for the non-signing inventors. The Office is not convinced that a diligent search was conducted. Petitioners should widen the scope of search beyond the confines of the Human Resource Department of the assignee. Searches of telephone registries and Internet databases and inquiries of temporary agencies that the assignee frequently utilized should be performed. A copy of the application

papers should be sent to the last known address of each non-signing inventor with a request that he sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventors, e.g. through computer or the telephone continue to fail, then applicants will have established that the inventors cannot be reached. An affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the non-signing inventors.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration does not contain the residence or post office address of either Mr. Bhagat or Mr. Bernstein. The address of the former temporary employer is not an acceptable substitute. In addition, the statement of citizenship for the non-signing inventors is ambiguous. Petitioners should make a statement in a renewed petition that to the best of their knowledge that the respective citizenships of Mr. Bhagat and Mr. Bernstein are as listed. The format of the declaration is not acceptable. The first page of the Declaration does not list all joint inventors and the Declaration does not include page numbers -- i.e. 1 of 2; 2 of 2. As such, there could be ambiguity with respect to how many inventors there are. The Declaration should set forth all of the joint inventors on the same page to ensure that each named inventor is aware of the other named inventors of the subject matter. See 37 CFR 1.63. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of Mr. Bhagat and Mr. Bernstein is REQUIRED. See MPEP 409.03(a).

As to item (4), a statement of both non-signing inventors last known address is missing and is required. The most recent home address (or place where mail was received) of both non-signing inventors should be listed.

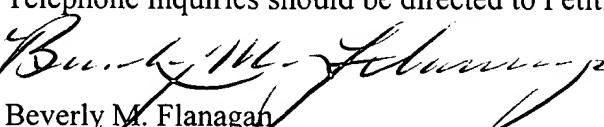
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
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By facsimile: (703) 308-6916
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